

REMARKS

Reconsideration of the present application is respectfully requested. No new matter has been added. No claims have been amended. Claims 1-23 remain in the application for consideration.

Rejections based on 35 U.S.C. § 103

Claims 1-3, 6-7, 9-11, 13-14 and 16 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,456,306 issued to Chin et al. ("Chin") in view of U.S. Patent Application No. US 2001/0056486 of Kosaka ("Kosaka"). Claims 4, 5, 8, 12, 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being obvious over Chin and Kosaka and further in view of U.S. Patent No. 5,581,797 issued to Baker et al. ("Baker"). Claims 18-23 stand rejected under 35 U.S.C. § 103(a) as being obvious over Chin in view of Kosaka and Baker. Applicants respectfully traverses all these rejections.

The office action has failed to establish a *prima facie* case of obviousness. The prior art must suggest the desirability of the claimed invention. MPEP 2143.01. The Office Action states that it would have been obvious to one of ordinary skill in the art to substitute the method of accessing network devices of Kosaka for the method of accessing network devices of Chin. *See* Office Action, p. 3. But Chin's method relies on human intervention in the form of a network manager to ensure that status changes are acknowledged. Removing this feature would render the Chin unsatisfactory for its intended purpose, and consequently there can be no suggestion nor motivation to make the proposed modification. MPEP 2143.01.

For example, Chin states that the network devices may be categorized according to state or device type, as **determined by the network manager**. *See* Abstract (emphasis added). "The method and apparatus provides a **network manager** with the ability to determine

the current state of network devices and objects within an enterprise network and invoke further actions such as configuration, performance, fault, and security management tasks." *See* Abstract (emphasis added). Thus, a network manager is relied upon in Chin to acknowledge status changes and take action. The process is intentionally not automatic. More particularly, Chin expressly states that "The network manager must click on the device icon and drag the icon to Ack tool 664, thereby moving the device icon from Acknowledge Status pane 640 to Operational Status pane 650, and changing the color of the icon to green." *See* col. 9, lines 3-7 (emphasis added).

The drag-and-drop techniques of Chin are further explained: "[t]his feature, in combination with the ability to click, drag and drop icons on to tools in tools bar 660, allow the network manager to keep integrated applications running and use drag and drop techniques in which an icon in one application is selected by cursor control device 523, e.g., a mouse, and dragged and dropped in window 600 of an embodiment of the present invention to obtain current status and fault information on critical network devices and objects." Moreover, Chin explains that "a network manager may **only** drag and drop a network device icon according to the status of the network device." *See* col. 9, lines 57-60. Chin provides the example that if device icon 603 were selected and dragged to the Ack tool 664, then the icon would turn red, indicating that the action is not allowed, since the device icon was not selected and dragged from Acknowledge States pane 640. *See* col. 10, lines 1-5.

Kosaka, however, does not offer any teachings or suggestions to modify Chin as asserted. To the contrary, the proposed modification would change the principle of operation of Chin; namely, employing a human being (network monitor) to acknowledge status changes of network devices. If the proposed modification or combination of the prior art would change the

principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See* MPEP 2134.01. Even if possible, the suggested combination of Kosaka with Chin would require a substantial reconstruction and redesign of Chin (for example, removing the click-and-drag functionality; eliminating common-status panes 610, 620, and 630; eliminating the tools pane 660) as well as a change in the basic principle under which Chin was designed to operate; namely, ensuring that a technician acknowledge status changes vis-à-vis acknowledge status pane 640. *See* MPEP §2134.01 citing *In re Ratti*, 270 F.2d 810 at 813, 123 USPQ 349 at 352 (CCPA 1959).

The Office Action acknowledges relies on the combination of Kosaka with Chin to support rejecting all of the pending claims, 1-23. But the Office Action fails to establish a *prima facie* case of obviousness at least because the proposed substitution of Kosaka's method for Chin's method would render Chin unsatisfactory for its purposes and the proposed modification would change the principle of operation of Chin. Because the Office Action does not provide a *prima facie* case, Applicants' respectfully request withdrawal of the rejection of claims 1-23.

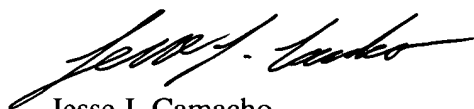
The Office Action also cites to Baker to support an obviousness rejection of claims 4, 5, 8, and 18-23. But Baker is neither in the field of Applicants' endeavor nor pertinent to the particular problem with which Applicants are concerned. MPEP 2145 § IX. As mentioned in Applicants' previous response, incorporated by reference herein, Baker describes a method and apparatus for displaying hierarchical information of a large software system, i.e. of more than one million lines of source code. *See* Abstract. Baker goes on to state that "[i]t is [the] object of the present invention to provide an apparatus for displaying information and statistics about the changes to the code of a large software system to enable technical personnel

to understand the relationship between its subsystem, directories and files.” See col. 2, lines 4-8. Thus, Baker is concerned with the problem of visually representing a complicated computer program, which is not the problem with which Applicants are concerned. Consequently, Baker cannot properly be relied upon to reject Applicants' claimed invention.

CONCLUSION

All of the claims in the application are believed to be in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and a Notice of Allowance be issued in this case. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 21-0765.

Respectfully submitted,



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